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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,758	12/04/2001	Donald J. Monroe	10541-636	8286

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CHICAGO, IL 60610

EXAMINER

RODRIGUEZ, PAMELA

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 01/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,758

Applicant(s)

MONROE ET AL.

Examiner

Pam Rodriguez

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-17,19-21 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17,19-21 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Amendment filed November 18, 2004 has been received and considered.

Specification

2. The amendment filed July 22, 2004 is still objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in paragraph 0020, the substitution of the words –circumferentially—for the words “radially” is new matter. Applicant has gone from describing his secondary edges 56 as being in one relation to the end face 50, “radially” disposed, and now recites that these edges are now circumferentially disposed. Further, applicant’s figures seem to support the original disclosure language of the secondary edges 56 being radially formed along the end face 50. While applicant has attempted to clarify this issue in his remarks, the two terms still are not synonymous with each other and thus the relationship of the secondary edges to the end face can be interpreted in two very different ways.

Applicant is required to cancel the new matter in the reply to this Office Action.

NOTE: per applicant’s remarks, the examiner’s previous objections to specification paragraph 0019 and the figure 5b drawing have since been withdrawn.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7, 9-17, 19-21, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnston.

Regarding Claim 1, Johnston discloses a pinion 14/18 moveable along an output shaft 10 of a starter assembly (see Figures 1 and 2) having all the features of the instant invention including: the pinion 14/18 having an inner surface 24 disposed about the output shaft 10 (see the new attached labeled Figures 1 and 2 of Johnston and the inner surface portion indicated therein, wherein since bushing 18 is integral with pinion 14, the inner surface is readable as the inner surface 24 of pinion bushing 18), the inner surface terminating at an end face of the pinion 14/18 (see the examiner's attached labeled Figures 1 and 2 of the Johnston reference depicting the inner surface and the end face as she now interprets them), wherein the inner surface and the end face are perpendicular with each other and define a secondary edge (see the examiner's attached labeled Figures 1 and 2 of Johnston, where the secondary edge is now more clearly indicated), wherein the pinion 14/18 comprises a primary edge (see Figure 2 and the middle groove 20, wherein the primary edge is readable as the right top edge of that groove nearest the top lead line of element numeral 24) for moving particles from the

shaft 10 as the pinion 14/18 moves along the output shaft (see column 3 lines 6-13), the primary edge being formed along a length of the inner surface (see Figure 2) and extending to the end face (see Figure 2), the primary edge defining a groove 20 in which the particles are received as the pinion 14/18 moves along the output shaft (see column 3 lines 6-13), and wherein the groove 20 is formed along the length of the inner surface 24 and adjacent the primary edge (see Figure 2).

Regarding Claim 2, Johnston further discloses that the pinion 14/18 is a one-piece pinion (readable as such, since in column 1 lines 67-68, the pinion 14 and bushing 18 are press-fit together and move together, thus the two parts are integral, and form a one-piece structure).

Regarding Claim 3, see column 1 line 58 – column 2 line 1.

Regarding Claim 4, see column 1 lines 58 et al.

Regarding Claim 5, Johnston further discloses a secondary edge for moving the particles from the primary edge, the secondary edge being defined at the juncture of the end face and the inner surface and being configured to move the particles from the shaft (see the examiner's attached labeled Figures).

Regarding Claim 6, see column 3 lines 6-13.

Regarding Claim 7, see Figure 2.

Regarding Claim 9, see the plurality of grooves 20 on the inner surface 24 shown in Figure 2 and note how each groove has its own separate primary edge as described in Claim 1 above.

Regarding Claim 10, see grooves 20 in Figure 2, each formed along the length of the inner surface 24 and adjacent each respective primary edge.

Regarding Claim 11, see Figure 2.

Regarding Claim 12, see Figure 2.

Regarding Claim 13, note how at least bushing 18, which is integral with pinion 14, is made of metal as disclosed in column 2 lines 6-7.

Regarding Claim 14, see the barrel portion shown in Figure 1 and a gear portion (see Figure 1 and the portion of pinion 14/18 labeled element numeral 14), wherein the end face and the inner surface 24 are adjacent the gear portion (see Figures 1 and 2).

Regarding Claim 15, see Claims 1 and 11 and note the bore of bushing 18 being readable as the bore of the inner surface 24 and that the angle formed at the secondary edge would be generally perpendicular (see the examiner's labeled figures).

Regarding Claim 16, see Claim 5 above.

Regarding Claim 17, see groove 20 of Figure 2 and column 3 lines 6-13.

Regarding Claim 19, see Figure 2 and grooves 20.

Regarding Claim 20, see Claim 10.

Regarding Claim 21, see Figure 2.

Regarding Claim 34, pinion assembly 14/18 is readable as being one-piece as the bushing portion 18 is press fitted to the pinion 14 and thus these elements can be said to be integral, i.e., one piece. See also column 1 lines 67 and 68 and column 2 line 1 where the reference teaches that these two components due to their press fitting move together as a "unit" and thus can be constituted as being one-piece.

Response to Arguments

5. Applicant's arguments filed November 18, 2004 have been fully considered but they are not persuasive.

Firstly, the examiner wishes to apologize for the Figure 2 drawing of the Johnston reference submitted to applicant. The office merely made a photocopy of the examiner's color-coded drawing instead of sending out the original, color copy as they were instructed. The examiner has since re-submitted this Figure 2 drawing in black and white labeled form with this office action as she originally interpreted it, to better clarify her position.

Thusly, as more clearly outlined in the rejections above and the new depiction of the Johnston Figure 2 drawing newly re-labeled, the examiner has better defined the inner surface, end face, and secondary edge portions of the Johnston reference as she interprets them. When Claims 1 and 15 are read in light of these defined elements, the Johnston reference still meets the limitations of the claims.

In response to applicant's arguments directed towards his statement of two surfaces not being perpendicular with each other merely because a line drawn along the first surface is perpendicular with a line drawn tangent to the arc of the second surface, the examiner contends that applicant's remarks are more specific than his claims. On this point, applicant merely claims that the inner surface and the end face are "perpendicular". The claim provides no means of limiting or defining how or in what plane of orientation this perpendicularity must exist. Therefore, the examiner's drawing

showing how a perpendicular relationship exists in the reference of Johnston can still meet the limitations of the claim.

It is for these reasons that the rejections have been maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pam Rodriguez whose telephone number is 703-308-3657. The examiner can normally be reached on Mondays 5 am -3:30 pm and Tuesdays 5 am -11 am.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3683

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Pam Rodriguez
Primary Examiner
Art Unit 3683
1/13/05

Pr
01/13/05

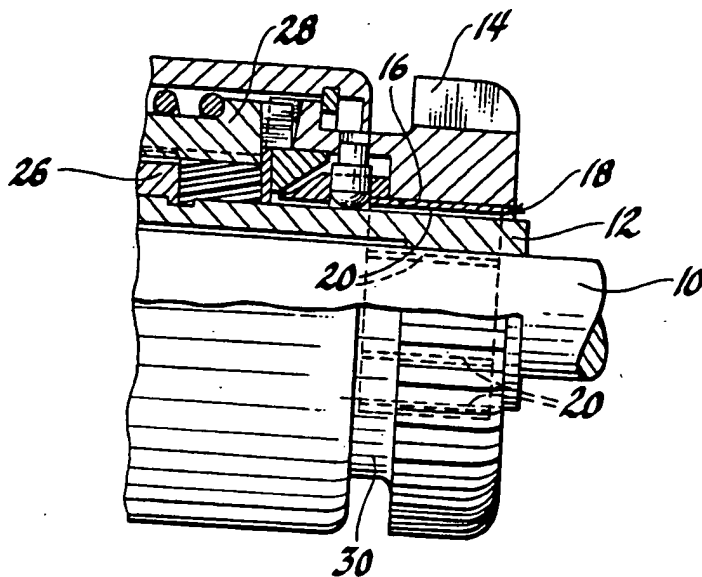


Fig. 1

end face = outer rim of 18

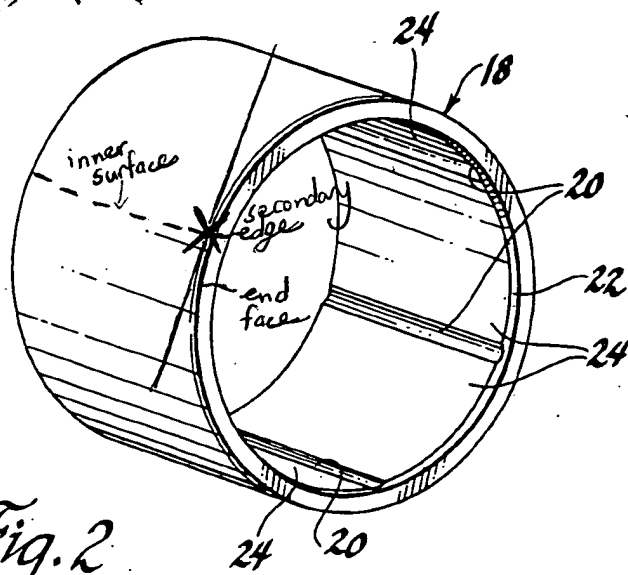


Fig. 2